

PATENT

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Examiner	:	WINDER, Patrice L.

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MS: Petitions  
Commissioner of Patents  
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**PETITION**

S I R:

Applicant petitions to reopen prosecution for compliance with the MPEP, Rules, and statutes set out below, for any or all of the following five reasons.

**1. Improper provisional double patenting rejection**

First, in the final rejection mailed on 02/28/2012, the Examiner issued an initial provisional double patenting rejection based on only one claim element. See pages 3-4. This rejection is an improper rejection because (A) all the claim limitations must be considered, (B) a mapping or matrix of the limitations is to be provided for the five patent applications and hundreds of claims at issue, i.e., for the pending hundreds of claims vis-a-vis claims 1-58 of Ser. No. 11/510,463, plus claims 1-63 of Ser. No. 11/510,351, plus claims 1-84 of Ser. No.

11/510,473, plus claims 1-37 of Ser. No. 11/836,633.

With respect to (A), consideration of all claim limitations, MPEP Sec. 804 states:

"the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis."

And MPEP Sec. 2142 states, in relevant part:

***Legal Concept of Prima Facie Obviousness [R-6]***

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), amended, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness

....

And MPEP Sec. 2143 states, in relevant part:

**2143.03 All Claim Limitations Must Be \*\*\*Considered< [R-6]**

\*\* "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

By considering only one claim element, the provisional patenting rejection issued in the final rejection did not comply with these sections of the MPEP nor the statutes and case law cited therein, and is therefore improper.

As to (B), a mapping or matrix of the limitations, MPEP Sec. 706 states, in relevant part:

...The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity....

37 CFR 1.104 Nature of examination.

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(c) *Rejection of claims.*

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. ***The pertinence of each reference, if not apparent, must be clearly explained*** and each rejected claim specified. (Italics and bolding added.)

And see too MPEP Secs. 2142-43, 2184.

As is customary in a massive, multiple reference double patenting rejection such as this is, the Office provides a mapping or matrix, or at least some consideration of the claim particularities and a proper claim analysis pursuant to 35 USC Sec. 103. Therefore, the provisional double patenting rejection is improper.

Further, the Examiner has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*. Otherwise, the rejection is improper. The Examiner has failed to meet this obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Absent a proper Sec. 103 analysis and the mapping or matrix of the claim limitations, and the information required by Rule 104 and Sec. 132, as well as compliance with the above-

cited portions of the MPEP, this is an improper provisional double patenting rejection.

**2. Examiner's improper handling of a substantive interview**

Second, the finality is improper for noncompliance with MPEP Sec 713.04 involving the failure to enter the Examiner's Interview Summary of the experts' testimony from that substantive interview conducted on November 17, 2011, with Dr. Chandrajit Baja, the undersigned, Professor Lee Hollaar, and the Examiner's supervisor. To summarize, as per Applicant's Request for Reconsideration, during the Interview Examiner Winder questioned Dr. Chandrajit Baja as to why it was not obvious to combine or modify Shastra as per his Declaration. Dr. Chandrajit Baja provided a detailed explanation, including addressing why the combination or modification would be contrary to the titled purpose of the Shastra system and would defeat that purpose, would have required a different approach to the data base structure and security requirements, and definitely was not obvious to those working on the project, and so far as Dr. Chandrajit Baja knew, they therefore did not even consider such a modification. Also, during the Interview, the Examiner was asked whether she had any further questions, and she said she did not.

The Examiner failed to enter the Interview Summary in compliance with the MPEP and instead wrote in the Office Action dated January 11, 2012, at pages 4-5:

The affidavit under 37 CFR 1.132 filed August 20, 2011 is insufficient to overcome the rejection of claims 1-58 based upon the Shastra as set forth in the last Office action because: applicant's rebuttal lacks evidence to support the assertion that there would be no motivation to combine Shastra collaboration system with a "control computer database serves as a repository of tokens for other programs to access, thereby affording information to otherwise independent computer systems". The evidence submitted to support the affidavit includes program code, dissertation and articles. Applicant has not pointed to anything specific in disclosed information that speculates or forecasts the utility of the Shastra system. Therefore, the affidavit is insufficient to support the assertion that the Shastra system would not provide motivation to incorporate a "control computer database serves as a repository of tokens for other programs to access, thereby affording information to otherwise independent computer systems".

The failure to enter the Interview Summary is improper pursuant to MPEP 713.04 and Rules cited therein, as is the absence of proper consideration given to the substance of the interview in the foregoing copy of the Examiner's remarks. It is also improper pursuant to Rule 104 and Sec. 132.

While it is recognized that the Applicant and the Examiner have responsibilities during a substantive interview, pursuant to MPEP 713.04, regardless of who initiated the interview

**Examiners must complete an Interview Summary form PTOL-413 for each interview where a matter of substance has been discussed during the interview...** (Bolding added.)

This was not done, whereas Applicant noted the content of the interview in the Request for Reconsideration filed on July 5, 2012.

MPEP 713.04 further states:

The Interview Summary form PTOL 413 shall be given an appropriate paper number, placed in the right hand portion of the file, and listed on the "Contents" list on the file wrapper. For Image File Wrapper (IFW) processing, see IFW Manual. In a personal interview, the duplicate copy of the Interview Summary form along with any attachment(s) is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephonic, electronic mail or video conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. In addition, a copy of the form may be faxed to applicant (or applicant's attorney or agent) at the conclusion of the interview. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Interview Summary form should be mailed promptly after the telephonic, electronic mail or video conference interview rather than with the next official communication.

The PTOL-413 form provides for recordation of the following information:

- (A) application number;
- (B) name of applicant;
- (C) name of examiner;
- (D) date of interview;
- (E) type of interview (personal, telephonic, electronic mail or video conference);
- (F) name of participant(s) (applicant, attorney, or agent, etc.);
- (G) an indication whether or not an exhibit was shown or a demonstration conducted;
- (H) an identification of the claims discussed;
- (I) an identification of the specific prior art discussed;
- (J) an indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by

attachment of a copy of amendments or claims agreed as being allowable). (Agreements as to allowability are tentative and do not restrict further action by the examiner to the contrary.); (K) the signature of the examiner who conducted the interview; (L) names of other U.S. Patent and Trademark Office personnel present.

The PTOL-413 form also contains a statement reminding the applicant of his or her responsibility to record the substance of the interview.

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview in each case unless the interview was initiated by the examiner and the examiner indicated on the "Examiner Initiated Interview Summary" form, PTOL-413B, that the examiner will provide a written summary. Where an interview initiated by the applicant results in the allowance of the application, the applicant is advised to file a written record of the substance of the interview as soon as possible to prevent any possible delays in the issuance of a patent. Where an examiner initiated interview directly results in the allowance of the application, the examiner may check the appropriate box on the "Examiner Initiated Interview Summary" form, PTOL-413B, to indicate that the examiner will provide a written record of the substance of the interview with the Notice of Allowability.

It should be noted, however, that the Interview Summary form will not be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant, or the examiner to include, all of the applicable items required below concerning the substance of the interview.

The complete and proper recordation of the substance of any interview should include at least the following applicable items:

(A) a brief description of the nature of any exhibit shown or any demonstration conducted;

(B) identification of the claims discussed;

(C) identification of specific prior art discussed;

(D) identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary form completed by the examiner;

(E) the general thrust of the principal arguments of the applicant and the examiner should also be identified, even where the interview is initiated by the examiner. The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner;

(F) a general indication of any other pertinent matters discussed;

(G) if appropriate, the general results or outcome of the interview...

None of this was done, and thus the Examiner's handling of the substantive interview is non-compliant with MPEP 713.04. This noncompliance is particularly relevant because 37 CFR 1.113(b) Final Rejection or Action provides:

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof

and examination could not have been compliant with this section of the CFR because the substantive interview was not properly made of record pursuant to MPEP 713.04.

And further, pursuant to MPEP Sec. 713.04:

**It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.** (Bolding added.)

The failure to enter an Interview Summary and PTO forms is improper pursuant to MPEP 713.04. Thus, except for Applicant's filing, there is no record of the interview, which is not normal in the Office's course of business. The Examiner having not provided an Interview Summary, the Applicant had no opportunity to agree or disagree with the content of what transpired in the interview, and this is improper - especially prejudicial in view of the Examiner's remarks quoted above and contradicted by the expert in the interview. The failure to comply with MPEP 713.04 and thus 37 CFR 1.113(b) is improper.

### **3. Failure to provide Rule 104 and Sec. 132 information**

Third, the Examiner's remarks mailed on April 17, 2012, fail to provide any "information" as to how the Declaration of Dr. Chandrajit Bajaj could be insufficient when the PTO has the burden of proof ... the Examiner provided no evidence whatsoever to contradict the Declaration of Dr. Chandrajit Baja....

Again, pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

Also again, in view of Sec. 132 and Rule 104, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". The Examiner has failed to meet this obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Applicant is entitled, pursuant to Rule 104 and Sec. 132 to the previously requested information, and the absence of a response with this information, is improper.

**4. Failure to give proper care / consideration to a Declaration and Interview; evidence of unobviousness**

Fourth, the Examiner failed to give proper care and consideration to Declaration and to the substance of the interview of Dr. Chandrajit Bajaj, which was ignored, not made of record, and clearly contradicts the above-quoted Examiner remarks, which also fail to consider the PTO's burden pursuant to Sec. 103.

MPEP Sec. 2142 states, in relevant part:

***If the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant.*** The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered



in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not.

***When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence.*** Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). See *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984) for a discussion of the proper roles of the examiner's *prima facie* case and applicant's rebuttal evidence in the final determination of obviousness. See MPEP § 706.02(j) for a discussion of the proper contents of a rejection under 35 U.S.C. 103. (Bolding and italics added.)

The Examiner ignored the interview with Dr. Chandrajit Bajaj, and pursuant to Sec. 103, there is no such thing as an Applicant's failure to meet a burden regarding a reason to combine when the Examiner has provided nothing to combine a reference with. In this case, the Applicant has no burden whatsoever. Objective evidence of non-obviousness must be considered as per Sec. 103, MPEP 2142, Rule 104, and Sec. 132, and the failure to do so is improper.

**5. Failure to give proper care / consideration to a Declaration; evidence of unobviousness**

Fourth, the Declaration of Professor Lee Hollaar, at paragraphs 14-17, provide evidence of unobviousness which received no consideration. Professor Hollaar's declaration states, in relevant part:

14. The description in the combination of Brown and Dieberger collectively is not adequate to allow a person skilled in the art to implement the claimed apparatus. There are no details given about how such an apparatus operates or how its hardware is configured.

15. The combination provides no substantial guidance to any implementation. In my

opinion, as much experimentation and development would be required as would be the case if the developer had never seen the combined references.

16. Had I provided a system description as in the combined references to one of my senior computer science project courses and asked them to produce a claimed apparatus, I would have been bombarded with questions regarding what I really wanted, because the assignment would have been far too vague. Had I provided the game transcript from Dieberger to students being asked to implement the claimed system, they would have thought that I had passed out the wrong material, since that contains no information of how to implement anything in the real world.

17. In sum, it is my opinion that the combination of Brown and Dieberger do not describe what the Examiner interprets, as stated above. Furthermore, the respective descriptions are so incomplete that a person skilled in the art at the time of the invention would have been unable to implement the claimed apparatus without undue experimentation and extensive development, with the combination of Brown and Dieberger providing no substantial help.

In response, the Examiner ignored Applicant's filed evidence stating, in the Advisory Action "the examiner is confused because the remarks refer to an affidavit of Dr. Chandrajit Baja. However, the affidavit is provided by Professor Lee Hollaar." Applicant grants that Applicant made a typographical error in the Remarks in the filing of April 2012, but not in the Transmittal Letter, and more so, a typographical error does not excuse ignoring Applicant's submitted evidence of unobviousness. See the Advisory Action. This is improper pursuant to MPEP Sec. 716.01(a) and cases cited therein.

MPEP Sec. 716.01(a), in relevant part, provides:

716.01(a) Objective Evidence of Nonobviousness [R-2] - 700  
Examination of Applications

716.01(a) Objective Evidence of Nonobviousness [R-2]  
OBJECTIVE EVIDENCE MUST BE CONSIDERED \*>WHEN TIMELY< PRESENT Affidavits or **declarations**>, when timely presented,< containing evidence of criticality or unexpected results, commercial success, long-felt but unsolved needs, failure of others, **skepticism of experts**, etc., **must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103**. The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983) that "evidence rising out of the so-called 'secondary considerations' must always when present be considered en route to a determination of obviousness." Such evidence might give light to circumstances surrounding the origin of the subject matter sought to be patented. As indicia of

obviousness or unobviousness, such evidence may have relevancy. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966); *In re Palmer*, 451 F.2d 1100, 172 USPQ 126 (CCPA 1971); *In re Fielder*, 471 F.2d 640, 176 USPQ 300 (CCPA 1973). The *Graham v. John Deere* pronouncements on the relevance of commercial success, etc. to a determination of obviousness were not negated in *Sakraida v. Ag Pro*, 425 U.S. 273, 189 USPQ 449 (1979) or *Anderson's-Black Rock Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969), where reliance was placed upon *A&P Tea Co. v. Supermarket Corp.*, 340 U.S. 147, 87 USPQ 303 (1950). See *Dann v. Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n. 4 (1976). (Bolding and italics added.)

The failure to give proper consideration to Applicant's submitted the evidence of unobviousness is improper.

II. **CONCLUSION**

Essentially, Applicant petitions for compliance with the MPEP, CFR, and statutory provisions set out above, whereby for any or all of the above-stated five reasons, the finality should be withdrawn to enable compliance. Favorable action is earnestly solicited in this petition, as Applicant cannot engage in fair prosecution and reply to the rejections and Examiner's remarks without the required information and compliance with the MPEP, CFR, and statutory sections set out above.

**APPLICANT CLAIMS LARGE ENTITY STATUS.** The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed, this shall be deemed a petition therefore. Please direct all communication to the undersigned at the address given below.

Respectfully submitted,



Date: August 28, 2012

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